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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,194	08/16/2005	Eric Prouzet	032013-110	8662
Burns Doane Swecker & Mathis P O Box 1404 Alexandria, VA 22313-1404			EXAMINER LE, HOA T	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 07/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/521,194

**Applicant(s)**

PROUZET ET AL.

**Examiner**

H. T. Le

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 112***

2. Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Gelling of the alginate is essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). In the specification, gelling of the alginate either simultaneously with crosslinking the inorganic matrix or in a separate step from the crosslinking step is required in order to form the claimed beads. However, the claims as amended fail to include such gelling step.

3. Claims 4, 6-13, 15, 23-27 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, it is unclear where the step of "gelling of the alginate" fits in the claimed process of claim 1 upon which claim 4 depends.

In claim 6, "gelling" (of the inorganic matrix) has no clear antecedent basis because only crosslinking of the inorganic matrix is previously described.

Claim 7 is deemed indefinite in view of its dependency on claim 6.

Claims 8 and 13 suffer the same deficiency of claim 6.

Claims 9, 12 and 13 are deemed indefinite in view of its dependency on claim 8,

In claim 10, "gelling of the alginate" has no antecedent basis because no step of gelling the alginate is previously recited.

Claim 11 is deemed indefinite in view of its dependency on claim 10.

Claim 15 suffers the same deficiency of claims 4 and 6.

In claim 23, the subject matter of the claim renders the claim indefinite because the product as recited is inconsistent with what is defined in claim 1 on which it depends.

Claim 1 is directed to a process of making beads while claim 23 recites a "material" formed of "beads" as the product resulted from the process claim 1, which recitation treats beads as an intermediate product rather than final product of the process claim 1. In addition, it is unclear how "gelled alginate" forms as there is no step of gelling the alginate described.

In claim 24, "gelling" has no antecedent basis. Further, it is unclear how the gelling step fits in the process as recited in claim 19 or claim 1 on which claim 24 depends.

Claims 25 and 26 suffer the same deficiency of claim 24.

Claim 27 is deemed indefinite in view of its dependency on claim 24.

In claim 29, "compound" has no antecedent basis. Is it intended to be dependent on claim 27 where "at least one compound" is recited?

***Claim Rejections based on Prior Art***

4. Claims 1-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dziedzic (US 4,063,856) as applied to the rejection of claims 23-27 set forth in the last office action and further discussed below.

5. Claims 1-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gerk (US 4,574,003) as applied to the rejection of claims 23-27 set forth in the last office action and further discussed below.

6. Claims 1-29 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Motai et al (US 4,797,358) as applied to the rejection of claims 23-27 set forth in the last office action and further discussed below.

***Response to Arguments***

7. With regard to process claims 1-22, Applicant argued that the prior art references do not teach a pH of less than 3 in the reaction medium. As stated in the last office action, the teaching of low pH in the prior art references would have encompassed a pH of less than 3. Alternatively, the teaching of low pH in the prior art references would have made it obvious to select a pH of lower than 3 as it is within the purview of "low pH".

8. With regard to process claims 1-22, Applicant's further argued that "obtaining a reaction medium having a pH of less than 3, for example, the gelling of the alginate and the crosslinking of the inorganic matrix can be carried out simultaneously". It is noted that the feature upon which applicant relies (i.e., gelling and crosslinking being carried out simultaneously) is not recited in the rejected claim(s). Particularly, no gelling of the alginate is even described in the independent process claim 1. Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

9. With regard to claims 23-27, Applicant argued that the prior art references do not teach a pH of less than 3 in the reaction medium. However, claims 23-29 are product-by-process claims, and the pH level does not appear to affect the characteristic properties of the resulting product. The burden is on Applicant to come forward with **evidence** establishing an **unobvious** difference between the claimed product and the prior art product. MPEP 2113. Applicant's argument that "obtaining a reaction medium having a pH of less than 3, for example, the gelling of the alginate and the crosslinking of the inorganic matrix can be carried out simultaneously" only relates to the process limitation and thus does not satisfy the burden of distinguishing between the resulting products, those that are resulted from the pH in reaction medium of less than 3 and those resulted from pH of higher than 3.

10. With regard to claims 28 and 29, additives including organic coloring agents are either immediately envisioned or are conventional in particulate material art. "For cosmetic use" is an intended use of the product, and thus is not a limitation in a patentable sense. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

11. Applicant's arguments filed March 24, 2008 have been fully considered but they are not persuasive for the reasons set forth above.

***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. (Holly) T. Le/  
Primary Examiner, Art Unit 1794

July 6, 2008